

**REMARKS**

**I. Disposition of the Claims**

Claims 1 to 32 and 59 are pending. Claims 1 to 58 have been rejected. Claims 1, 4, 5, 6, 14, and 27 have been amended. Claim 59 is new.

**II. General Comments**

The Appendix contains a version with markings to show changes made to the claims in compliance with Rule 121.

Claims 4, 5, 6, 14, and 27 have been amended to correct inadvertent typographical errors. Claim 27 has been amended to clarify the language of this claim without altering its scope.

Claim 1 has been amended to replace "at least 10%" with --greater than 9%--. Support for this amendment can be generally found in the present specification. For example, the present application describes a prior art composition comprising carnuba wax (9%), beeswax (11.1%), and hydroxycellulose (1.5% and a film former). While carnuba wax is included within the "at least one wax" as recited in claim 1, beeswax, being too soft and melting at too low of a temperature, is not. See the present application at page 12, line 15-page 13, line 4. Thus, there is only 9%, *i.e.*, the amount of carnuba wax, of the "at least one wax" as listed in this composition.

The present application further states that the "at least one wax" being present in an amount of 9% is "outside the invention." See the present application in the upper right hand corner of the table on page 24. Reading the passages stating the "at least one wax" being present in an amount of 9% is "outside the invention" and the "at least one wax" may be present without limitations being placed on its amount, as generally

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described in the present specification, reasonably would have conveyed to persons of ordinary skill in the art that the present inventors (Bertrand Piot *et al.*) invented the claimed method reciting a composition comprising "at least one wax . . . present in an amount of greater than 9%" as recited in amended claim 1. Accordingly, new matter has not been added.

New claim 59 is supported by claim 1 as filed and the specification as filed (*e.g.*, the same passages that support amended claim 1 and p. 5, lines 10-12).

### **III. Rejections under 35 U.S.C. § 112, Second Paragraph**

The Office rejects claim 51 for the reasons found on page 2 of the outstanding Office Action. Applicants respectfully submit that this claim has been canceled in item 4 of the transmittal letter accompanying the original filing of this application. Thus, Applicants respectfully request that this rejection be withdrawn.

### **IV. Double Patenting under 35 U.S.C. § 101**

The Office rejects claims 33 to 57 for the reasons found on page 2 of the outstanding Office Action. Applicants respectfully submit that these claims have been canceled. Thus, Applicants respectfully request that this rejection be withdrawn.

### **V. Nonstatutory Double Patenting Rejection**

The Office has rejected claims 1 to 32 and claim 58 over the parent patent (U.S. Patent No. 6,274,131 B1) under the judicially created doctrine of obviousness-type double patenting for the reasons found on page 3 of the outstanding Office Action. Applicants respectfully submit that claim 58 has been canceled and request that this rejection be withdrawn with respect to this claim. As for the remaining claims,

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Applicants state their intent to file a terminal disclaimer in the event that any one of these claims becomes allowable.

**CONCLUSION**

In view of the foregoing amendment and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office is invited to contact Applicant's representative Sean A. Passino at (202) 408-6065 to answer any questions about this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

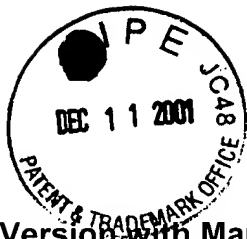
Respectfully submitted,

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Dated: December 11, 2001

By: 

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**Appendix: Version with Markings Showing the Changes Made**

The Appendix displays the Changes in the traditional, but abandoned, format.

**IN THE CLAIMS:**

1. (Amended) A method of curling and/or thickening keratin fibers comprising [the step of] applying to said keratin fibers an effective amount for said curling and/or thickening of a mascara composition comprising:
  - (i) a wax-in-water emulsion of at least one wax having a needle penetration ranging from 1 to 7.5 and a melting point ranging from 70°C to 110°C, wherein said at least one wax is present in an amount of [at least 10] **greater than 9%** by weight relative to the total weight of said composition, and further wherein said at least one wax is in the form of particles greater than or equal to at least 1 µm in size and
  - (ii) at least 0.1% by weight, relative to the total weight of said composition, of a polymer system containing at least one film-forming polymer, wherein said polymer system is capable of forming a film which produces, at a concentration of 7% in water, a greater than 1% retraction of isolated stratum corneum at 30°C and under a relative humidity of 40%.
4. (Amended) A method according to claim 1, wherein said at [least] **least** one wax is selected from rice bran wax, carnauba wax, candelilla wax, montan waxes, sugar cane waxes, and polyethylene waxes.
5. (Amended) A method according to claim 1, where at least one wax having said needle penetration has a melting point of at least 77°**C** and less than 83 °C.
6. (Amended) A method according to claim 1, wherein said at least one wax is **a** rice bran wax.

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14. (Amended) A method according to claim 12, wherein said at least one wax having a melting point ranging from 70°C to less than 77°C is present in an amount ranging from 5% to 20% by weight[, ] relative to the total weight of said waxes.

27. (Amended) A method according to claim 25, wherein the weight ratio of said at least one wax having a needle penetration ranging from 1 to 7.5[. and said melting point ranges from 77 °C to 110 °C] to said at least one wax having [a melting point of at least 50 °C and less than 70 °C and] a needle penetration of greater than 7.5 ranges from 2:1 to 5:1, wherein said at least one wax having a needle penetration ranging from 1 to 7.5 has a melting point ranging from 77 °C to 110 °C.